

**REMARKS**

Applicant has carefully reviewed the Final Office Action dated November 17, 2004, and the Advisory Action mailed February 2, 2005, Applicant respectfully requests reconsideration of the present application in view of the following remarks.

**A. Advisory Action**

In the advisory action mailed February 2, 2005, the Examiner has expressed confusion with Applicant's remarks. Therefore, Applicant includes the previous response filed on January 18, 2004, and offers clarifications in Section E of this paper.

**B. Claim Rejections – 35 U.S.C. § 102**

Claims 14, 15, and 18 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Stephenson et al* (2,514,811). For at least the following reasons, Applicant respectfully traverses the rejection.

To anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As illustrated in *Stephenson*, the washer 20 (incorrectly illustrated as 19 in FIG. 3) and washer-nut 29 (that both bolts thread into) are separate items (See FIG. 3 and column 2 line 54-column 3, line 4). Furthermore, washer 20 (incorrectly illustrated as 19 in FIG. 3) and washer-nut 29 and cannot be integral since the annular member illustrated as 16 in FIG. 3 could not be assembled on the mount due to the flange of washer-nut 29 at one axial end of annular member 16 and the flange of washer 20 at the opposite axial end of annular member 16.

Applicant also notes that independent claim 14 has been amended to include the limitation "wherein said integral tubular member extends through at least a portion of said isolator." Support for this limitation can be found in paragraphs [0013] – [0017] and FIGS. 1-5.

Stephenson does not disclose an upper base with an integral tubular member that extends through at least a portion of an isolator, as illustrated and described in the present application and as positively recited in amended claim 14.

Dependent claims 15 and 18 are patentable by being dependent on an allowable base claim 14. Therefore, withdrawal of the rejection and allowance of claims 14, 15, and 18 are respectfully requested.

### **C. Claim Rejections – 35 U.S.C. § 103**

Claims 1-7, 11, 16, 17 and 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Stephenson et al* (2,514,811) in view of *Peterson et al* (4,921,203). For at least the following reasons, Applicant respectfully traverses the rejection.

MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish prima facie obviousness as follows: “To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

### **Independent Claims 1 and 20**

A case of obviousness requires that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP § 2143; *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), *W.L. Gore and Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (CAFC, 1966).

Moreover, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

#### NO MOTIVATION

Applicant respectfully traverses the 103(a) rejections because there is no suggestion, motivation, or objective reason to combine the cited references. “If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.” *In re Rouffet*, 47 USPQ2d 1453 at 1457 (Fed Cir. 1998). “Rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability’.” *Id.* quoting *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

The Examiner has cited three advantages for combining Stephenson with the first and second tubular member construction of Peterson. These advantages are discussed, in turn, below. Applicant respectfully submits that these purported advantages would not motivate one to combine the references for at least the reasons below.

#### Both Sides

The examiner states that one skilled in the art would be motivated, with Stephenson in hand, to seek out Peterson to find a mounting that does not require that a fastener be screwed from each side (See Office Action, paragraph 6; Stephenson, FIG. 3). However, FIG. 2 of Stephenson illustrates an embodiment of the same mounting that does not require that a fastener be screwed from each side. Additionally, the mounting of FIG. 2 of Stephenson requires a nut on the opposite of the side of the fastener, in similar fashion as Peterson.

Therefore, one skilled in the art, with Stephenson in hand, would not be motivated to seek out a reference to teach a mounting that does not require that a fastener be screwed from each side, as asserted by Examiner, as this teaching is contained in Stephenson.

### Misalignment

The examiner also states that one skilled in the art would be motivated, with Stephenson in hand, to seek out Peterson to find a mounting that reduces misalignment. A detailed review of the mounts disclosed in Stephenson and Peterson does not reveal any misalignment advantages associated with Peterson that do not exist in Stephenson. To the contrary, the mount of Stephenson, either FIG. 2, or FIG. 3, is to be assembled in two steps that would seem to reduce alignment problems associated with aligning multiple items (elastomers, spacers, washers, body panels, brackets, etc.). In the first step of Stephenson, the lower portion of the mounting 15 is attached to the bracket 14 by tightening either T-shaped bolt 19 (FIG. 2) or bolt 30 (FIG. 3). In the second step, the body 28 is attached to mounting 15 by either bolt 27 (FIG. 2) or bolt 31 (FIG. 3). By teaching a two step process, misalignment problems are reduced as fewer items must be aligned when inserting a bolt therethrough.

Indeed, FIG. 2 of Stephenson requires that the T-shaped bolt 19 be interposed through 4 items (puck 17, flange 16, puck 18, and washer 20) before the nut (illustrated above as N) is threaded onto T-shaped bolt 19. However, Peterson requires that at least 7 items [item M (not named, but appearing to be an automobile body or cab), spacer 12, first elastically resilient mating ring 16, item S (not named, but appearing to be an ear extending from an automobile frame), second elastically resilient mating ring 18, spring element 100, and thimble 14] be assembled before fastener 20 can be threaded onto nut 51. Therefore, misalignment would be more likely with Peterson than Stephenson, and accordingly, one skilled in the art, with Stephenson in hand, would discard Peterson when looking for a mounting that reduces misalignment. The only mention of aligning within Peterson is for aligning tabs 108 that assist in engaging thimble 14 with spring element 100 *after* the 7 items mentioned are aligned for assembly.

### Failure of Fastener

The examiner further states that one skilled in the art would be motivated, with Stephenson in hand, to seek out Peterson to find a mounting that would not fall apart in the event of a fastener failure. A close examination of Peterson reveals that failure of fastener 20 would result in separation of the automobile body M from the ear S of the automobile frame. Although

Applicant questions the likelihood of one skilled in the art desiring that a mount hold together when the body separates from the frame of an automobile during a fastener failure or other postulated accident, the mount of Stephenson affords an identical attribute. In the event of a failure of either bolt 27 (FIG. 2) or bolt 31 (FIG. 3), the remainder of mount 15 would not fall apart. Thus, one skilled in the art, with Stephenson in hand, would not need to look to Peterson, or any other reference, to find a mounting that would not fall apart in the event of a fastener failure since Stephenson fulfills this need.

#### Stephenson and Peterson

The advantages listed by the Examiner, and discussed above, to motivate one skilled in the art to combine Stephenson and Peterson fail to meet the burden required in *ex parte Levengood* for establishing a *prima facie* case of obviousness. Applicants cannot locate any motivation within the references to support this combination. Therefore, withdrawal of this rejection and allowance of the rejected claims are respectfully requested.

#### Dependent Claims

It is well known that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

Dependent claims 2-7, 11, 16, 17, 21, and 22 teach independently patentable subject matter, although they are also patentable merely by being dependent on an allowable base claim. As an example, dependent claims 5 and 17 positively recite the limitation that the second, or tubular member 22 "includes a dimple for engaging a fastener." In contrast, the thimble tube cylindrical portion 42 of Peterson does not appear to be a dimple, and clearly is not taught to engage threaded portion 82 of fastener 20. (See column 5, lines 1-9).

**D. Claims 8, 19, and 23**

Claims 8, 19 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Stephenson et al* (2,514,811) as modified by *Peterson et al* (4,921,203) in view of *Schmidt* (3,390,709). For at least the following reasons, Applicant respectfully traverses the rejection.

Applicant notes that dependent claims 8, 19, and 23 depend from independent claims 1, 14, and 20, respectively. Accordingly, these claims are allowable by being dependent on an allowable independent claim.

**E. Advisory Action**

In response to the Advisory action dated February 2, 2005, please consider the following remarks:

*In re Fritch* provides that “the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art,” and that “the Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” 23 USPQ2d. 1780, at 1783. In focusing efforts to meet this burden, the Federal Circuit concluded that “under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.” *Id.* (Emphasis in original) The Examiner has combined the first and second tubular members of Peterson with the device of Stephenson to reject the claims. Applicant maintains that Peterson cannot be properly combined with Stephenson.

With regard to the Examiner’s incentive that one with the mount of Stephenson in hand look to Peterson to eliminate the need to have a fastener screwed from both sides, Applicant was operating under the assumption that the Examiner was referring to the fastener of FIG. 3 of Stephenson that must be screwed from both sides. In the remarks of January 18, 2005, Applicant was presenting the fact that FIG. 2 of Stephenson provides a fastener that must be assembled in similar manner as the fastener of Peterson requires. Therefore, it is unclear how the fastener of Peterson that must be screwed from one side as a nut is secured from rotation,



provides an advantage over the fastener as taught in Stephenson, that must be screwed from one side as a nut is secured from rotation (FIG. 2).

Motivation to look to another reference necessarily requires that the problem cannot be solved by the reference in hand. That is, one must have a reference that solves part of one's problem, and have some incentive to look to another reference that solves the remainder of the problem. Assuming *arguendo* that one were motivated to use the fastener of Peterson in the device of Stephenson, *thereby eliminating need to have a fastener screwed from both sides*, then at best this combination would result in the device of Stephenson and the fastener of Peterson. Applicant is confused as to how this combination would result in the first and second tubular members of Peterson being combined with the device of Stephenson, since the Examiner's purported advantage does not lead one to this combination.

With regard to the alignment advantage, the Examiner is not providing a motivation to combine the first and second tubular members of Peterson with the device of Stephenson, but the Examiner is again providing a motivation to replace the fasteners of Stephenson with a single bolt and nut combination as provided in Peterson. As presented in the advisory action, the Examiner's advantage of a single bolt that, when tightened, eliminates the deficiency in Stephenson of possibly realigning the first tightened fastener further supports Applicant's contention that there is no reasonable motivation to combine these references. The Examiner has admitted that it is the single bolt of Peterson that solves the purported alignment problem, and not the first and second tubular members of Peterson that prevents the mount from being assembled in a misaligned condition.

With regard to the mount not falling apart in the event of a fastener failure, Applicant may be willing to accept this as a fact, but is unsure as to how this is an advantage. In the mounts of both Stephenson and Peterson, any fastener failure would result in the cab of a vehicle losing at least a portion of its dynamic restraint to the frame of the vehicle. Since these mounts provide only deadweight support of the cab of a vehicle at rest, an operator would not necessarily know of a fastener failure until the cab and the frame begin to separate during operation of the vehicle. Applicant's line of reasoning is that the Examiner has failed to explain

what incentive one skilled in the art would have to desire to provide a mount that remains intact during a catastrophic failure of a critical vehicle component.

The Examiner's reasons to combine Stephenson and Peterson are better suited as reasons why one would choose Peterson instead of Stephenson, which does not establish a *prima facie* case of obviousness by providing a motivation to combine.

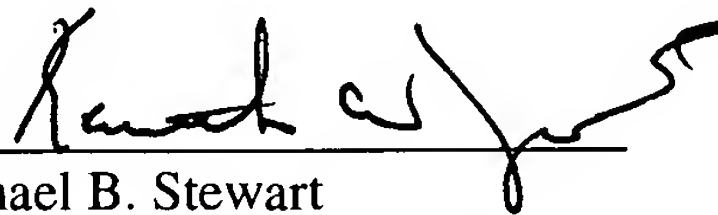
### CONCLUSION

In view of the above amendment and remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

It is believed that any additional fees due with respect to this paper have already been identified in any transmittal accompanying this paper. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge our Deposit Account No. 18-0013, under Order No. 60680-1638 from which the undersigned is authorized to draw.

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Respectfully submitted,

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